



GOBIERNO DE PUERTO RICO
DEPARTAMENTO DE ESTADO



October 23, 2022

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221 Ponce de León Avenue Piso 5
San Juan, PR 00917

SUBJECT MATTER

MARK

CLASS

FILING NUMBER

FILING DATE

APPLICANT

Office Action

ASURION TECH REPAIR & SOLUTIONS

035

247499-35-0

March 24, 2022

UBreakIFix, Co.

To whom it may concern:

In order to proceed with the examination of the said mark Applicant must submit the following information:

- X 1. State clearly the goods or services in connection with the mark as used or intended to be used in commerce in Puerto Rico. This applies if the Applicant customized the selection of goods or services.
- 2. Provide a drawing of the mark as used or as intended to be used in commerce in Puerto Rico.
- 3. Provide a detailed description of the mark as used or as intended to be used in commerce in Puerto Rico.
- 4. Provide a specimen that shows the mark in connection with the goods or services identified in your application.
- X 5. Applicant must disclaim those terms or components of the mark which are not susceptible of exclusive appropriation.
- 6. Others.
- 7. The registration for the applied mark is refused on the following grounds:

- A. **Description of services is overly broad:** An application for the registration of a mark must specify the particular goods or services on or in connection with which the Applicant uses, or has a *bona fide* intention to use, the mark in commerce. To “specify” means to name in an explicit manner. The identification should set forth common names, using terminology that is generally understood. The identification of goods and/or services must be specific, definite, clear, accurate, and concise.

The wording “**business advisory services relating to the establishment of franchises and business advisory services relating to the operation of franchises, all in the field of smartphones, cellular telephones, handheld digital electronic devices, game consoles, handheld computers, tablet computers, laptop computers, desktop computers, GPS navigation devices, household and business electric and electronic products, household and business devices and appliances, and goods which utilize the internet of things, and repair, technology support, parts, and accessories for the aforementioned**” in the recitation of services is overly broad and must be clarified.

The applicant must amend the recitation to specify the common commercial name of the goods and/or services or to indicate their nature. The applicant may adopt the following recitation of services under International Class **035** if accurate:

- business **management** advisory services relating to the establishment of franchises and business **management** advisory services relating to the operation of franchises, all in the field of smartphones, cellular telephones, handheld digital electronic devices, game consoles, handheld computers, tablet computers, laptop computers, desktop computers, GPS navigation devices, household and business electric and electronic products, household and business devices and appliances, goods which utilize the internet of things, and **including franchises offering** repair, technology support, parts, and accessories for the aforementioned.

Please note that these amendments are illustrative and not exhaustive.

The Applicant is referred to the *International Classification of Goods and Services under the Nice Agreement* provided by the World Intellectual Property Organization (<http://www.wipo.int/classifications/nivilo/nice/index.htm?lang=EN>) for assistance in describing the specific goods or services in relation to which the Applicant uses the mark in commerce. An applicant may amend an

identification of goods or services only to clarify or limit the goods or services; adding to or broadening the scope of the goods or services is not permitted.

- B. Disclaimer of Non Registrable Components:** Applicant must disclaim descriptive wording from the mark as shown because it merely describes an ingredient, quality, characteristic, function, feature, purpose or use of applicant's goods and/or services. See §171d of the Puerto Rico Trademark Act, 10 L.P.R.A. §171d, *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005); *In re Gyulay*, 820 F.2d 1216, 1217-18, 3 USPQ2d 1009, 1010 (Fed. Cir. 1987).

The term "**TECH**" is an abbreviation of the word "**technologies**" and it refers to digital and electronic products as a group. Please see attached definitions <https://www.ahdictionary.com/word/search.html?q=technologies>

Applicant must disclaim the wording in the mark because "**TECH**" merely describes an ingredient, quality, characteristic, function, feature, purpose, use of applicant's goods, or is primarily geographically descriptive of the origin of those goods.

The term "**SOLUTIONS**" refers to methods for dealing with problems. Please see attached definition <https://www.ahdictionary.com/word/search.html?q=solutions>

Applicant has indicated that its services are used in repair services. Thus, the phrase "**TECH REPAIR & SOLUTIONS**" refers to repair of digital and electronic products and providing the means to deal with problems related to those goods or services. In the context of applicant's services, the phrase merely describes their purpose. Accordingly, a disclaimer is required.

The following disclaimer is added:

"NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TECH REPAIR SOLUTIONS**" APART FROM THE MARK AS SHOWN.**

In light of the aforementioned, the Examiner requires the Applicant to modify and/or amend the application for registration as provided herein or, otherwise, show cause why such modification is not required.

According to Rule 36 of Puerto Rico's Trademark Rules of Procedure amendments filed must be specified in a written and signed statement by the Applicant or its Representative. Neither Applicant nor its Representative shall rewrite, alter, modify, erase or include words in a pending application. However, the Puerto Rico Trademark Office (PRTTO) may amend the said application with the Applicant's consent.

According to Rule 27 of Puerto Rico's Trademark Rules of Procedure, if the PRTTO does not receive a response to the abovementioned remarks within ninety **(90) days**, the Application shall be considered abandoned.

Note: Please refer to the name of the Examining Attorney. The office action response shall be filed online at <https://prtmfiling.f1hst.com/>. The cost for the said filing is **\$15.00**. If you have any questions send them via email to slebron@estado.pr.gov or to marcas@estado.pr.gov.

Cordially,

A handwritten signature in blue ink, reading "Shakira Lebrón".

Shakira L. Lebrón Muñoz, Esq.
Examining Attorney
Puerto Rico Trademark Office